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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,844	09/19/2003	Kevin R. Stone	CROL-114CP2CN3 (56290-097)	6044
23630	7590	01/17/2006	EXAMINER	
MCDERMOTT WILL & EMERY LLP ATTN: INTELLECTUAL PROPERTY DEPARTMENT DOCKETING 28 STATE STREET BOSTON, MA 02109			SAUCIER, SANDRA E	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/665,844

**Applicant(s)**

STONE ET AL.

**Examiner**

Sandra Saucier

**Art Unit**

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/19/03, 12/24/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

#### DETAILED ACTION

Claim 1 is pending and is considered on the merits.

#### *Specification*

The disclosure is objected to because of the following informalities: Please update the status of the parent applications. Both 10/062341 and 09/824327 have been abandoned.

Appropriate correction is required.

#### *Information Disclosure Statement*

The listing of the references on PTO 1449 is incomplete. A proper citation includes AUTHOR, TITLE, JOURNAL, VOLUME, NUMBER, INCLUSIVE PAGES, (month), YEAR. The citation of LaVecchio et al. is missing the year of publication.

MPEP37 CFR 1.98(b) requires that each publication must be identified by author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is

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appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 7 of U.S. Patent No. 5,902,338 [A]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US 5,902,338 have a non-limiting range of glycosidase which encompasses the instant range of about 1mU/ml to about 1000U/ml.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,110,206 [B].

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US 6,110,206 have a non-limiting range of glycosidase which encompasses about 1 mU/ml to about 1000U/ml as instantly recited.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,210,440 [C]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is open to further steps of which treatment with sialic acid is one of the optional treatments described in the instant specification. Thus, the instant claim is broader and encompasses the claims of US 6,210,440.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1-5 of U.S. Patent No. 6,231,608 [D]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are open to further treatment with an aldehyde as described in paragraph 39 of the instant specification. Thus, the instant claims are co-extensive to the claimed method of US 6,231,608.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,402,783 [E]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is open to further steps such as a capping step which is described in the instant specification. Thus, the instant claim is broader and encompasses the claims of US 6,402,783.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1, 2, 4, 5, 7-10 of U.S. Patent No. 6,758,865 [F]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is

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open to further steps such as capping with fucosyl, sialyl and other molecules (paragraph 0046).

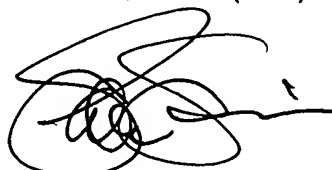
***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (571) 272-0922. The examiner can normally be reached on Monday, Tuesday, Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Sandra Saucier', with a large, stylized initial 'S' and a horizontal line extending to the right.

Sandra Saucier  
Primary Examiner  
Art Unit 1651  
January 11, 2006